

**REMARKS**

This Amendment, filed in reply to the Office Action dated July 25, 2006, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-32 are all the claims pending in the application.

**1. Claim Rejections Under 35 U.S.C. § 103**

The Examiner has rejected claims 1, 3, 4, 6, 7, 11, 14-17, 24, 27 and 28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,361,203 to Hiyama *et al.* (“Hiyama”) in view of U.S. Patent No. 6,690,417 to Yoshida *et al.* (“Yoshida”). For at least the following reasons, Applicant respectfully traverses the rejection.

Claim 1 recites an image storage and display system that comprises a “storage control means [that] is capable of changing a compression ratio of said irreversible compressed image data.” The Examiner concedes that Hiyama does not disclose this feature but applies Yoshida to allegedly cure the deficiency.

In response to the arguments in the filing of May 1, 2006, the Examiner concedes that Hiyama does not disclose that the compression ratio needs to be controlled. (Office Action at page 2.) However, the Examiner contends that one skilled in the art would have combined the teachings of Hiyama and Yoshida in order “to control the amount of data to be stored in the memory.” (Office Action at page 4.) The Examiner contends that “since the compressed data amount needs to be controlled in Hiyama, the change of compression ratio in Yoshida can be

used for the control. Thus, the Yoshida reference can be combined with Hiyama to obtain the invention as specified in claims 1 and 14.” (Office Action at page 2.)

Applicant submits that the Examiner is intermixing two independent concepts. These concepts are “compression ratio” and “changing the compression ratio.” To control the compression of image data to a desired amount, the image data may be compressed at a desired ratio, e.g. 1/2. This is an entirely different concept than changing the compression ratio, for example, from 1/5 to 1/50. Although controlling the compression of image data may provide a motivation to compress data to a given desired ratio, it does not provide a motivation to change the compression ratio. That is, why would one skilled in the art change the compression ratio when a fixed ratio provides the desired result?

Mere “identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). “[T]here must be some **motivation, suggestion or teaching of the desirability** of making the specific combination.” *Id.* (emphasis added.)

In the present case, the Examiner has not provided the motivation to modify the system of Hiyama to include a changeable compression ratio. The Examiner’s contention that “since the compressed data amount needs to be controlled in Hiyama, the change of compression ratio in Yoshida can be used for the control” is not a motivation to combine the references since the desirability of changing the compression ratio in the system of Hiyama is not taught by either reference. The fact that a reference can be modified is not enough to establish a *prima facie* case of obviousness. (MPEP § 2143.01.III)

Since, as conceded to by the Examiner, there is no disclosure or suggestion of changing the compression ratio in Hiyama, one skilled in the art can only presume that the data compression taught by Hiyama is at a fixed ratio, and the motivation to add a changeable compression ratio must come from Yoshida. However, for at least the reasons given below, Yoshida also does not provide the suggestion to modify a system such as that disclosed in Hiyama to include a changeable compression ratio.

Applicant submits that the data loss associated with the variable compression as taught by Yoshida may be detrimental in a system that requires high-quality images since it could create an image with too much data loss. The Examiner's contention that "data loss [] never occurs" (Office Action at page 2) in Yoshida is not supported by the disclosure in Yoshida. Yoshida discloses "that the photographing mode is classified into four stages: superfine mode, fine mode, normal mode, and economy mode, and that the image size after compression is classified into four stages: 400 KB, 200 KB, 100 KB, and 50 KB." (Col. 22, lines 57-61.)

Clearly, if an image is stored in superfine mode with 400 KB of image data, it will have more details than an image stored in economy mode with 50 KB of image data. In this example, there would be 350 KB of lost image data if an image was stored with 50 KB of data rather than 400 KB of data due to storage constraints. Although such a loss of image data may not be critical for the digital camera/telephone disclosed in Yoshida, the loss of image data would be very critical for the medical endoscope images of Hiyama.

As conceded to by the Examiner (Office Action at page 2), the system in Yoshida primarily looks at available space when varying the compression ratio (Abstract). There is no

disclosure or suggestion that other factors (e.g., the subject matter of the image) are considered when varying the compression ratio. Accordingly, one skilled in the art would not have combined the teachings as suggested by the Examiner, and the Examiner has failed to make a *prima facie* case of obviousness for this additional reason.

The Examiner's contention that “[b]ecause the combined system does teach every claim feature, a *prima facie* case of obviousness has been established” (Office Action at page 2) is not supported by the MPEP. The MPEP clearly states that in order to

1. To establish a *prima facie* case of obviousness, three basic criteria must be met. **First**, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP §2143.

Therefore, even if, for the sake of argument alone, the cited art did disclose all the claimed elements, only one criteria out of the three has been met for establishing a *prima facie* case of obviousness. Applicant submits that, for at least reasons given above, the Examiner has not established that the first and second criteria for establishing a *prima facie* case of obviousness have been met.

Because claim 14 recites features similar to that of claim 1 and the Examiner's rejection of claim 14 is similar to that given in claim 1, we would submit that the Examiner has failed to

make a *prima facie* case of obviousness for at least reasons similar to those given above with respect to claim 1.

Claims 3, 4, 6, 7, 11, 15-17, 24, 27 and 28 are patentable at least by virtue of their respective dependencies.

In addition, claim 24 recites that “the server creates two irreversible compressed images of said original image data.” (emphasis added)

The Examiner concedes that “the endoscope image data and the ultrasonic image data are **both** original image data” (Office Action at page 2, emphasis added), but still contends that the requirements of claim 24 are met.

Applicant submits that the Examiner’s rejection is clearly improper since the Examiner concedes that Hiyama uses two original images, not one as set forth in claim 24.

## **2. Allowable Subject Matter**

The Examiner has indicated that claims 5, 8-10, 12, 13 and 18-23 are allowable and that claims 25 and 26 would be allowable if rewritten in independent form. Applicant defers rewriting these claims 25 and 26 in abeyance until the subject matter regarding claim 1 is resolved.

In the reasons for allowance, the Examiner partially quotes the features of claim 5 and does not accurately quote the language in claims 8-10.

Claim 6 is amended for purposes of clarity and is patentable based on its dependency. New claim 33 should be entered as a matter of course due to its dependency on claim 6.

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. Appln. No. 09/774,885

Attorney Docket No. Q62892

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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